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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,099

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Keiji Nishikiori

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EXAMINER

CHU, KIM KWOK

ART UNIT

PAPER NUMBER

2627

NOTIFICATION DATE

DELIVERY MODE

09/30/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/578,099	Applicant(s) NISHIKIORI ET AL.	
	Examiner Kim-Kwok CHU	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Pre-Amendment filed on May 3, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 3, 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Drawing Objection

1. Figure 8 should be designated by a legend such as --Prior Art--because it is a conventional optical recording medium according to Applicant's specification, section 40.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 26, 27 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 26, last line, the phrase "a user data area" is not clear because its location on the recording medium's layers, such as the light transmitting layer or light absorption layer, is not mentioned in Claim 18. Furthermore, it is not clear whether or not the claimed user data area is a transmittance-changed area.

Similarly, in Claim 30, last line, the phrase "a user data area" is not clear because its location on the recording medium's layers, such as the light transmitting layer or light

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absorption layer, is not mentioned in Claim 28. Furthermore, it is not clear whether or not the claimed user data area is a transmittance-changed area.

The claims not specifically mentioned above are rejected because these claims are dependent on the rejected base claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless -
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. Claims 18-30, 33 and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yamasaki et al. (U.S. Patent 6,440,516).

6. Yamasaki teaches an information recording apparatus having all the elements and means as recited in claims 18-27, 33 and 34. Yamasaki teaches the following:

Regarding Claim 18, the optical information recording medium (Fig. 1) comprising a substrate 1 (Fig. 1; column 3, line 28), a light transmitting layer 2 (Fig. 1; column 24) formed on the substrate 1 and a light absorption layer 3 (Fig. 1; layer 3

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does not reflect light), wherein: transmittance of the light transmitting layer 2 is changed irreversibly upon irradiation of recording light to record information (Fig. 1; abstract; lines 5 and 6).

Regarding Claim 19, the change in the transmittance of the light transmitting layer 2 caused by irradiation of recording light is in a direction to reduce transmission of reproduction light or recording and reproduction light (Fig. 1; the transmitting layer 2 facing the light reduce the light transmission).

Regarding Claim 20, the light transmitting layer 2 is formed with a resin sheet (column 5, line 16-19; polycarbonate is a resin).

Regarding Claim 21, the resin sheet is formed of a polycarbonate resin, an acryl resin, or a polyolefin resin (column 5, line 16-19; polycarbonate is a resin).

Regarding Claim 22, the light transmitting layer 2 further includes an adhesive resin 3 for adhering the resin sheet to the substrate 1 (Fig. 3).

Regarding Claim 23, the adhesive resin 3 is formed with a UV curable resin included therein (Fig. 1; column 6, lines 13-16).

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Regarding Claim 24, the adhesive resin 3 is formed of an acryl gluing agent (Fig. 1; adhesive includes acryl glue).

Regarding Claim 25, the light transmitting layer is formed of one or more layers of a UV curable resin (column 5, lines 58-60).

Regarding Claim 26, at least one transmittance-changed area of the light transmitting layer 2 is formed in an area other than a user data area (Fig. 3; light transmittance can be changed in the whole layer).

Regarding Claim 27, the transmittance-changed area is formed on an inner side or outer side of the user data area, or both the inner and outer sides (Fig. 3; light transmittance can be changed in the whole layer).

Regarding to Claim 33, the light transmitting layer 2 generates the change in transmittance by cleaving (heading) molecules of a light transmitting layer material with irradiation of recording light (Fig. 1; abstract; lines 5 and 6).

Regarding Claim 34, the molecules of the light transmitting layer 2 are cleaved by thermal shock (thermal printing with laser light).

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7. Method claims 28-30 are drawn to the method of using the corresponding apparatus claimed in claims 18, 19 and 26. Therefore method claims 28-30 correspond to apparatus claims 18, 19 and 26 and are rejected for the same reasons of anticipation as used above.

8. Claims 31 and 32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Honda et al. (U.S. Publication 2002/0191517).

9. Honda teaches a recording and reproduction apparatus having all the elements and means as recited in claims 31 and 32. Honda teaches the following:

Regarding Claim 32, the recording and reproduction apparatus (Fig. 6) for an optical information recording medium 10 (Fig. 1) having a substrate 12, a first recording area including an information recording layer 14 (Fig. 1; section 0030), and a second recording area including a light transmitting layer 18 (Fig. 1; label layer; section 0030), comprising: light irradiation unit 66 (Fig. 6) operable to irradiate the first recording area 14 and the second recording area 18 with recording light (Fig. 11A and 11B); and switching unit 62 (Fig. 6; system control performs data recording on layer

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14 or label printing on layer 18) operable to switch a recording mode of the light irradiation unit between the first recording area 14 and the second recording area 18 (section 37, first 5 lines), wherein the light transmitting layer is irradiated with modulated recording light from above and transmittance of the light transmitting layer is changed to record information in the second recording area (section 0036, modulation is performed by vibration signal generation circuit 80), and information is reproduced (read) based on the change in the transmittance (Fig. 10).

10. Claim 31 has limitations similar to those treated in the above rejection, and is met by the reference as discussed above.

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Related Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bronson (6,864,907) is pertinent because Bronson teaches an optical recording disc having a light transmitting layer for writing disc label.

McClellan (6,862,033) is pertinent because McClellan teaches an optical recording disc having a light transmitting layer for writing disc label.

Wilson et al. (4,961,077) is pertinent because Wilson teaches an optical recording disc having a transmitting layer for writing disc label.

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12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (571) 272-7579.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

/Kim-Kwok CHU/

Examiner AU2627
September 17, 2010
(571) 272-7585

/William J. Klimowicz/

Primary Examiner, Art Unit 2627